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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,959	07/30/1999	KEN HAYWARD	690-008568-U	1141

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MARK F HARRINGTON  
PERMAN AND GREEN LLP  
425 POST ROAD  
FAIRFIELD, CT 06430

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/364,959

Applicant(s)

HAYWARD ET AL.

Examiner

Madeleine AV Nguyen

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

This communication is responsive to Response After Final filed on October 25, 2002.

### *Response to Amendment*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Murai (US Patent No. 5,592,307).

Concerning claim 1, Murai discloses an electronic assembly (Figs. 1 and 2) comprising an image transfer device (2) for reading and transferring an image from a first medium, the image transfer device including a reader (108) for reading the image on the first medium, and a display (150, Fig.3) for displaying an image transfer menu for effecting transfer of the image; and a computer (4); wherein when the image transfer device is inactive or not in used, a first type of menu is displayed on the display device, and when the image transfer device is active, a second type display menu is available for display on the display device (Figs. 3, 46; Abstract;

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col. 4, line 66 – col. 5, line 67; col. 8, lines 47-63; col. 13, line 21 – col. 14, line 54; col. 66, line 20 – col. 69, line 28).

Concerning claims 2-3, Murai further teaches that the image transfer device is at least one of a copier, a fax machine or a printer (Figs.1, 2); and it includes a processor (200, Fig.4), for controlling operation of the device, a memory (202, 204, 206), a user interface (Fig.3).

Concerning claims 4-13, Murai further teaches that the second type of the image transfer menu is stored in the memory of the transfer device, the computer has software for enabling the display means to display the first or second type of menu wherein at least a portion of the second type of the image transfer menu is stored in the computer and the second type menu includes expanded features for operating the image transfer device; the first type of the menu includes a base set of different features which is commonly known for computer operations; the image transfer device is a fax machine and the extra feature is at least one of an extended phone log selection feature or adding a logo, a message or watermark; the image transfer device is adapted to transfer the image to a local/remote devices or printing device for printing the image; the computer is adapted for sending a polling signal (Figs. 3, 45, 46, 47; col. 4, line 66 – col. 5, line 67; col. 8, lines 47-63; col. 9, line 39 – col. 10, line 67; col. 13, line 21 – col. 14, line 54; col. 17, line 26 – col. 18, line 57; col. 66, line 20 – col. 69, line 28).

Concerning claims 14-18, Murai discloses the subject matters as discussed in claims 1-13 above.

Claims 19-26 are method claims of apparatus claims 1-13. Claims 19-26 are rejected as claims 1-13.

*Conclusion*


4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Nakai et al (US Patent No. 5,964,457) discloses an image forming system having a transfer device for communicating between image forming apparatus and image processing apparatus.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



AV  
January 8, 2003

Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2622